

Toth et al.

S/N:10/765,618

REMARKS

In the Office Action mailed August 8, 2005, the Examiner imposed a restriction requirement and requested that Applicant either elect claims 1-8 (Group I) drawn to a tomographic system, and classified in class 378, subclass 4, or claims 9-32 (Group II) drawn to a system and method of object positioning, and classified in class 378, subclass 195. The Examiner indicated that groups I and II were related as combination and subcombination. Applicant elected claims 1-8 of Group I, with traverse, and requested reconsideration of the requirement for restriction in the Amendment/Response to August 8, 2005 Restriction Requirement that was filed with the USPTO on August 11, 2005. The Examiner made final the requirement for restriction in an Office Action mailed October 26, 2005, withdrew claims 9-32 from consideration, and issued an action on the merits for claims 1-8. Responsive thereto, Applicant petitions for review of the requirement for restriction and requests consideration of the remarks hereinafter in support of the rejoinder of claims 9-32.

It is well-established that "where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon restriction; i.e., separate classification, status, or field of search." MPEP §806.05(c) (emphasis added). As set forth below, sufficient reasons do not exist for insisting upon restriction.

Applicant previously argued that it believed that class 378, subclass 205 is a more appropriate classification for the identified inventions rather than the 378/4 and 378/195 respective classification/sub-classifications afforded by the Examiner. Subclass 205, as set forth in the Manual of Patent Classification, is the appropriate subclass for inventions directed to "subject matter including means designed to aid in the alignment of source, object, or detector relative to one another." As each of the identified inventions is directed to subject matter that aids in determining the position of the object relative to the x-ray source and/or x-ray detector, it is believed that both inventions should be commonly classified in subclass 205.

Applicant does not believe that the inventions when commonly classified "have formed a separate subject for inventive effort" as required under MPEP §808.02. That is, the MPEP provides that restriction may be proper despite a common classification "when an explanation indicates a recognition of separate inventive effort by inventors." *Id.* The Examiner may show a separate status in the art "by citing patents which are evidence of such separate status, and also a separate field of search." *Id.* Applicant requested that the Examiner provide an explanation that indicates a recognition of separate inventive effort or patents evidencing such separate status as

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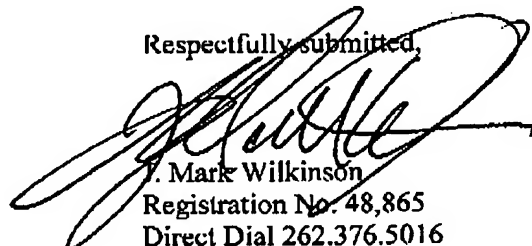
required by MPEP §808.02; however, the Examiner has failed to do so and, as such, has failed to satisfy the requirement that the inventions have formed a separate subject for inventive effort.

Additionally, the Examiner has failed to show that a different field of search is required for the identified inventions. Applicant submits that the search for group I will necessarily entail a search of group II, and vice-versa. Specifically, group I includes "at least one sensor to provide subject-position feedback." Thus, a search of the elected invention will necessarily include a search of subject matter called for in claims 9 and 19 of group II. While Applicant acknowledges that claims 9 and 19 call for limitations beyond the acquisition of subject-position feedback; nevertheless, any search of claims 9 and 19 would necessarily include the search for such a limitation, which is also found in claim 1 of group I. Thus, it is believed that the Examiner has not shown that a different field of search is required for the pair of identified inventions.

Therefore, given that a common classification is more appropriate for the identified inventions and "the field of search is the same and there is no clear indication of separate future classification and field of search," it is believed that "no reasons exists for dividing among [the] related inventions." *Id.* For at least these reasons, Applicant believes the restriction made by the Examiner to be improper and, therefore, requests supervisory review thereof.

Any questions regarding this matter may be directed to the undersigned.

Respectfully submitted,



J. Mark Wilkinson
Registration No. 48,865
Direct Dial 262.376.5016
jmw@zpspatents.com

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P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170